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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,517	10/23/2003	Shinichi Yamamura	00862.023279.	6061
5514	7590	08/04/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			PHAM, HAI CHI	
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NEW YORK, NY 10112			PAPER NUMBER	

2861

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,517

Applicant(s)

YAMAMURA, SHINICHI

Examiner

Hai C. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 12, 18 and 20 is/are allowed.
- 6) ☒ Claim(s) 7-9, 13-15, 19 and 21 is/are rejected.
- 7) ☒ Claim(s) 10, 11, 16 and 17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>08/27/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7-8, 13-14, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi (U.S. 6,690,911).

Yamagishi discloses an image forming apparatus having a sheet reversing and discharging device (2) for printing at least body text and tab data on both sides of print sheets including a tab print sheet, comprising a setup reception unit configured to receive a print setup (e.g., by pressing the tab sheet mode key 27 to select a tab sheet mode) (col. 7, lines 60-63), a check unit configured to check in accordance with the received print setup if the print process of the printing apparatus is that on the tab paper sheet ("the controller 50 determines whether or not the sheet is a tab sheet Pt by referencing the tab sheet mode key 27" in Step S3, Fig. 10A) (col. 8, lines 13-16). Once the first side of the tab sheet is printed, the controller executes a routine A for reversing

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the tab sheet to be conveyed back to the image forming station for printing the second side of the tab sheet by setting a particular reversal timing for each tab sheet.

Although Yamagishi does not explicitly disclose the second command that pauses the print process after the first side of the tab sheet has been printed, the image forming apparatus would not process the printing on the second side of the tab sheet until the above-mentioned particular reversal timing set by the controller has elapsed. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate an interrupt command to pause the printing process of the tab sheet on its second side as claimed during the reversal in the conveyance of the tab sheet since it is necessary for maintaining printing job integrity in conducting such duplex printing process.

With regard to claim 8, Yamagishi further teaches a command being issued that instructs to execute a print process of the body text data in accordance with the received setup when said check unit determines that the print process of the printing unit is not that on the tab paper sheet (routine B).

With regard to claims 19 and 21, Yamagishi further teaches a microcomputer (51) including a CPU, which executes the print process program stored in the ROM (col. 7, lines 52-60).

The method claims 13-14 are deemed to be clearly anticipated by functions of the above structures.

4. Claims 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi in view of Hirako (U.S. 6,758,471).

Yamagishi discloses all the basic limitations of the claimed invention except for the print style setup unit configured to receive designation of a print style on the tab paper sheet, and an insertion position setup unit configured to receive an insertion position of the tab paper sheets among body text pages.

Hirako discloses an image forming apparatus for printing on tab sheets in different print styles (e.g., simplex-print mode and duplex-print mode), wherein a timing control is set in different control modes, e.g., control modes A, B and C, depending on the insertion position of the tab sheets with respect to the tab location, e.g., the tab is located on the leading, trailing or side edges of the tab sheet.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Yamagishi with the aforementioned teaching of Hirako. The motivation for doing so would have been to allow the controller to set appropriate timing control independent from the loading of the tab sheets, which can be loaded in any arbitrary orientation when simplex or duplex printing is executed.

Allowable Subject Matter

5. Claims 1-6, 12, 18 and 20 are allowed.

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6. Claims 10-11 and 16-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is an examiner's statement of reasons for allowance: Claims 1 and 12 are patentable over the prior art patents and printed publications because of the specific configuration of the printing apparatus, which includes a notification unit to output a message to a user when the check unit determines the print process on the tab paper sheet and the print unit prints on a first face of the tab paper sheet, and a detection unit to detect the re-storage of the tab paper sheet, the first face of which has been printed, back in the original storage unit, and wherein in response to that detected signal, the print unit prints on the second face of the tab paper sheet. The combined limitations as claimed are not taught by the prior art of record alone or in combination.

The primary reason for the indication of the allowability of claims 10 and 16 is the inclusion therein, in combination as currently claimed, of the limitation wherein "said fourth command issuance unit issues a blank page non-billing command that instructs to execute a non-billing blank page print process on a reverse face of the print sheet on which the body text data immediately before the tab paper sheet is printed when the number of body text pages before the tab paper sheet is odd", which is not found taught by the prior art of record considered alone or in combination.

The primary reason for the indication of the allowability of claims 11 and 17 is the inclusion therein, in combination as currently claimed, of the limitation of when "the number of body text pages before the tab paper sheet is odd, said fourth command

issuance unit issues a 2-sided print command that instructs to print the body text data in a 2-sided print mode before execution of the print process of the body text data, and issues a 1-sided print command that instructs to print the body text data in a 1-sided print mode before execution of the print process of the body text data immediately before the tab paper sheet", which is not found taught by the prior art of record considered alone or in combination.

Claims 2-6, 18 and 20 are allowable because they are directly/indirectly dependent from claims 1 and 12 above.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C. Pham whose telephone number is (571) 272-2260. The examiner can normally be reached on M-F 8:30AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on (571) 272-1934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HAI PHAM
PRIMARY EXAMINER

August 3, 2005